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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,440	02/02/2004	Mitsunori Hirano	2870-0273P	8904

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EXAMINER	
LE, HOA VAN	
ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/768,440	HIRANO ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 12-15 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 02 February 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date —.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This application is before the examiner for consideration on the merits.

A. Claims 1-15 are generic to a plurality of disclosed patentably distinct species comprising (1) compounds of the general formula I, (2) compounds of the general formula II, (3) compounds of the general formula III and (4) compounds of the general formula IV. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Mr. Marc S. Weiner states that applicants elect compounds of the general formula I. They have been considered and searched. Other non-elected compounds of the general formulas II, III and IV will be considered, searched and examined when all of the applications of the elected compounds of the general formula I are overcome. Accordingly, claims 12-14 having the none-elected compounds of the general formulas II, III and IV are without as being related to the non-elected species.

C. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a photographic material, classified in class 430, subclass 570.

II. Claim 15, drawn to a method for developing an image of an exposed photographic material using a developing solution containing the specific compound, classified in class 430, subclass 489.

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for developing an image of an exposed photographic material can be practiced with a known black-and-white developing solution or commercially available black-and-white developing composition. Applicants show or provide a convincing evidence to the contrary. In the absence of such evidence, the restriction on the record would not be removed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper since an additional search is burdensome.

However, the method claim 15 is depended on the elected material claim 1. According, the method claim 15 is permitted to be rejoined when the material claim 1 is found to be allowable.

D. During a telephone conversation with Mr. Marc S. Weiner on 01 April 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claim 15 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

E. Applicants' prior art submissions filed on 02 February and 24 June 2004 have been considered to the extent of the English language as provided.

F. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Morishima et al (5,994,040).

Morishima et al disclose and teach a silver halide black-and white photographic material comprising a support having thereon (1) a silver halide emulsion layer containing (a) silver halide grains of 40% or more silver bromide and being spectrally sensitized with (b) a

compound being read on the general formula I as claimed, (c) an organic polymer and (d) inorganic particles and (2) a hydrophilic colloid layer. The material contains a hydrazine containing compound as a contrast promoting agent in amount of from 0.000 001 mol per mol of silver. The coated silver is 0.5 g/m^2. The material contains a conductive layer having ion conductive polymer. There is a gelatin containing undercoat layer in between the support and the silver halide light sensitive layer. Please see the whole disclosure of the reference, especially at col.93:51-53 and 65, 98:14-16, 159:57-60, 180:46-5, 181:27-32, 197:41-43, 199:40-50, 207:16, 208:33-35, 209:53-54, 210:41 to 211:9, chemical structure of the spectrally "Sensitizing Dye-1" on cols.211 and 212, 212:62.

Morishima et al disclose and teach a conductive layer containing inorganic metal oxide particles and ion conductive polymer on one side of the support but do not specify the property of "surface resistivity..." as that in claims 4 and 6. It is reasonable to considered it to be inherent since the conductive layer contains the ion conductive chemical ingredients in the absence of convincing evidence to the contrary. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429.

Morishima et al disclose and teach the chemical structure of the spectrally "Sensitizing Dye-1" being read within the general formula I as claimed but do not specify the property of "dissolved in water..." as that in claim 8. It is reasonable to considered it to be inherent in the absence of convincing evidence to the contrary. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429.

Since Morishima et al are reasonably disclosed and taught the claimed embodiments, the claims are found to be anticipated by Morishima et al.

G. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishima et al. (5,994,040) considered in view of Arai (5,876,907).

Morishima et al disclose and teach a silver halide black-and white photographic material comprising a support having thereon (1) a silver halide emulsion layer containing (a) silver halide grains being spectrally sensitized with (b) a compound being read on the general formula I as claimed, (c) an organic polymer and (d) inorganic particles and (2) a hydrophilic colloid layer. The material contains a hydrazine containing compound as a contrast promoting agent in amount of from 0.000 001 mol per mol of silver. The coated silver is 0.5 g/m^2. The material contains a conductive layer having ion conductive polymer. There is a gelatin containing undercoat layer in between the support and the silver halide light sensitive layer. Please see the whole disclosure of the reference, especially at col.93:51-53 and 65, 98:14-16, 159:57-60, 180:46-5, 181:27-32, chemical structure of the spectrally "Sensitizing Dye (S-5)" on col.192:20-25, 197:41-43, 199:40-50, 207:16, 208:33-35, 209:53-54, 210:41 to 211:9, chemical structure of the spectrally "Sensitizing Dye-1" on cols.211 and 212, 212:62.

Morishima et al disclose and teach a conductive layer containing inorganic metal oxide particles and ion conductive polymer on one side of the support but do not specify the property of "surface resistivity..." as that in claims 4 and 6. It is reasonable to considered it to be inherent since the conductive layer contains the ion conductive chemical ingredients in the absence of convincing evidence to the contrary. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429.

Morishima et al disclose and teach the chemical structure of the spectrally "Sensitizing Dye-1" being read within the general formula I as claimed but do not specify the property of "dissolved in water..." as that in claim 8. It is reasonable to considered it to be inherent in the absence of convincing evidence to the contrary. For a property of a material, it is allowed to request and require applicants to show a convincing evidence to the contrary in accordance with the authority stated in In re Schreiber, 44 USPQ2d 1429.

Morishima et al also use silver halide grains having 50 mol% or more silver chloride. However, Arai disclose, teach and suggest that the use of silver halide grains having high mol% of silver bromide have the advantage of obtaining high sensitivity of "130" in a rapid developed photographic material than that of high mol% of silver chloride with "117" at Table 1 on cols.61-62 with Samples 5 and 12.

Since the above references are all related to silver halide black- and-white photographic material for a rapid developing process, it would have been obvious to one having ordinary skill in the art to use silver halide grains containing high mol% of silver bromide from Arai for a

reasonable expectation of obtaining high sensitivity in a rapid developing process than those of high mol% of silver chloride as disclosed, taught and suggested in Arai et al.

H. Varescon et al (6,150, 083) and Winkel et al (6.383,711) are cumulative to the teachings and suggestions in the above applied Morishima et al.

G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

Hoa Van Le
05 April 2005